

ESTTA Tracking number: **ESTTA670230**

Filing date: **05/01/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206212
Party	Defendant entrotech, inc.
Correspondence Address	LISA M. GRIFFITH FISH & RICHARDSON P O BOX 1022 MINNEAPOLIS, MN 55440 1022 UNITED STATES tmdoctc@fr.com, hickey@fr.com, martens@fr.com, dylan-hyde@fr.com, mor- ris@fr.com
Submission	Motion to Strike
Filer's Name	Erin M. Hickey
Filer's e-mail	tmdoctc@fr.com, hickey@fr.com, ly@fr.com, morris@fr.com
Signature	/Erin M. Hickey/
Date	05/01/2015
Attachments	2015-05-01 Motion to Strike - Halsey Discovery Deposition.pdf(161067 bytes ) 2015-05-01 Declaration of ENH ISO Mtn to Strike Halsey.pdf(173774 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial Nos.:

85/499,349 for the mark **CHLORADERM**  
85/499,345 for the mark **CHLORABSORB**  
85/499,337 for the mark **CHLORABOND**  
85/499,332 for the mark **CHLORADRAPE**

Filed on December 19, 2011

Published in the *Official Gazette* on May 29, 2012

CAREFUSION 2200, INC.,

*Opposer,*

v.

ENTROTECH LIFE SCIENCES, INC.,

*Applicant.*

Combined Opposition Proceeding No.: 91-206,212

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE OF RELIANCE  
OFFERING IN EVIDENCE THE DISCOVERY DEPOSITION OF NON-PARTY  
WITNESS, MR. JOHN HALSEY, UNDER 37 C.F.R. § 2.120(j)**

Applicant Entrotech Life Sciences, Inc. ("Applicant") respectfully moves this Trademark Trial and Appeal Board (the "Board") to strike Opposer's Notice of Reliance offering in evidence the discovery deposition of non-party witness, Mr. John Halsey, on grounds the Notice of Reliance plainly violates the Trademark Rules of Practice, which guide the admissibility of evidence in the Board's proceedings.

## **LEGAL STANDARD**

A party may move to strike an adversary's notice of reliance, in whole or in part, on grounds that the notice of reliance does not comply with the procedural requirements of the particular rule under which it was submitted. *See* T.B.M.P. § 532; *Boyd's Collection Ltd. v. Herrington & Co.*, 65 U.S.P.Q.2d 2014, 2019-20 (T.T.A.B. 2003) (striking the offering party's notice of reliance offering in evidence testimony by affidavit when the adverse party never stipulated to the submission or admissibility of same).<sup>1</sup>

"The discovery deposition *of a party* (or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party) may be offered in evidence *by any adverse party*." *See* T.B.M.P. § 704.09 (emphasis original). Otherwise, the discovery deposition of a witness, whether or not a party, **may not be offered in evidence** unless the parties have stipulated to its admissibility, if the offering party has established a showing of exceptional circumstances for allowing the discovery deposition to be in evidence, or if, during the offering party's testimony period, the witness was dead, outside of the United States, unable to testify because of age, illness, infirmity, or imprisonment, or could not be served with a subpoena to compel attendance at a testimonial deposition, all of which would require the Board's approval. *Id.*

## **ARGUMENT**

Here, Opposer's Notice of Reliance offering the discovery deposition of non-party witness, Mr. John Halsey, which was taken under Rule 30(b)(1) of the Federal Rules of Civil Procedure, plainly does not meet the requirements of admissibility under Rule 704.09 of the

---

<sup>1</sup> Should the Board defer the merits of Applicant's Motion to Strike for after the final hearing on this matter, Applicant hereby reserves its right to maintain its objection to the admissibility of the discovery deposition of Mr. Halsey in its trial brief and at the hearing on this matter.

Trademark Rules of Practice and this Board should strike it from the record in this proceeding.<sup>2</sup>

In particular, Mr. Halsey was not “a party or ... an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure” at the time his discovery deposition was taken on December 12, 2014 and none of the exceptions listed in the Rule applies – perhaps the most important of which is that Applicant never stipulated (nor was it ever asked to stipulate) to the admissibility of Mr. Halsey’s discovery deposition. *See* 37 C.F.R. § 2.120(j); T.B.M.P. § 704.09.

Importantly, Opposer’s Notice of Reliance has misled the Board in claiming that Mr. Halsey was the “President” of Applicant on the date of his discovery deposition – December 12, 2014. Opposer is well aware that Mr. Halsey did not have that position when his deposition was taken. Although Mr. Halsey was, at one time, the “President” of Applicant, Mr. Halsey no longer held that position when his deposition was taken on December 12, 2014, which he made very clear to Opposer’s counsel. Indeed, Mr. Halsey confirmed during his discovery deposition that he now was simply a consultant to Mr. Jim McGuire and not involved at all in the day-to-day decisions for Applicant and its business:

Q. And what is your current occupation?

A. I am a consultant for Entrotech Life Sciences.

(Deposition of John Halsey (“Halsey Deposition”) at pg. 4:16-17).

Q. Okay. Now, you are no longer employed as an Entrotech Life Sciences employee; correct?

A. I am employed, I’m on payroll, but I’m acting as a consultant to Mr. McGuire, and I’m not involved in the day-to-day decision making for Life Sciences.

Q. Okay. When did that happen?

A. October 24.

Q. Of –

A. 2014.

---

<sup>2</sup> Applicant requests that Mr. Halsey’s discovery deposition and its exhibits be stricken from the record in this proceeding.

(Halsey Deposition” at pg. 26:7-15). Annexed hereto as **Exhibit A** to the Declaration of Erin M. Hickey, Esq. (“Hickey Decl.”) are true and correct copies of pages 4 and 26 from the discovery deposition of John Halsey taken on December 12, 2014.

Mr. Halsey’s deposition testimony confirms that his role with Applicant changed nearly two months before his discovery deposition. In other words, Mr. Halsey was no longer serving as the President of Applicant on the date of his discovery deposition (and still is not today). Mr. Halsey’s minor role as a consultant to Mr. McGuire, which does not involve him at all in the day-to-day business decisions for Applicant, and which was the position he held when he was deposed by Opposer, surely does not meet the criteria for his discovery deposition to be admissible under 37 C.F.R. § 2.120(j).

Not only was Mr. Halsey not a “a party or ... an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure” at the time his discovery deposition was taken on December 12, 2014, but none of the exceptions for otherwise providing for the admissibility of the discovery deposition of such a witness is applicable here (nor has Opposer tried to argue that any is in its Notice of Reliance, for that matter). Opposer also has not claimed that any “exceptional circumstances” exist, and it is very clear that Applicant never stipulated to the admissibility of Mr. Halsey’s discovery deposition. As a result, Opposer’s Notice of Reliance seeking to offer the discovery deposition of Mr. Halsey in evidence is plainly invalid under the Trademark Rules of Practice and this Board should strike it. *See Hilson Research Inc. v. Society for Human Resource Management*, 27 U.S.P.Q.2d 1423, 1427 (T.T.A.B. 1993) (discovery deposition of non-party witness not allowed in evidence as “the simple fact is that he was no longer an officer or director at the time of his deposition”); *Houghton Mifflin Company, Inc. v. Tabb*, 2002 WL

519268, at 8, n. 6 (T.T.A.B. Apr. 3, 2002) (“Opposer’s notice of reliance upon the discovery deposition of a non-party has been stricken . . . as not falling within any of the exceptions[.]”); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 U.S.P.Q.2d 1321, 1325 (T.T.A.B. 1992) (notice of reliance for discovery deposition of non-party witness stricken as “improperly filed under the rules” as there was no question that the witness was no longer an officer, director, or managing agent when his deposition was taken).

### **CONCLUSION**

Applicant respectfully requests the Board to strike Opposer’s Notice of Reliance offering Mr. Halsey’s discovery deposition and its exhibits in evidence from the record.

Respectfully submitted,

Date: May 1, 2015

/s/ Erin M. Hickey

Lisa M. Martens

Erin M. Hickey

FISH & RICHARDSON P.C.

P.O. Box 1022

Minneapolis, MN 55440-1022

Telephone: (858) 678-5070

Facsimile: (858) 678-5099

*Attorneys for Applicant,*

ENTROTECH LIFE SCIENCES, INC.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing document has this 1<sup>st</sup> day of May, 2015 been mailed by electronic mail, as agreed to by counsel for the parties, to Opposer's counsel of record:

Joseph R. Dreitler, Esq.  
Mary R. True, Esq.  
DREITLER TRUE, LLC  
[jdreitler@ustrademarklawyer.com](mailto:jdreitler@ustrademarklawyer.com)  
[mtrue@ustrademarklawyer.com](mailto:mtrue@ustrademarklawyer.com)

\_\_\_\_\_  
/s/ April R. Morris  
April R. Morris

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial Nos.:

85/499,349 for the mark **CHLORADERM**  
85/499,345 for the mark **CHLORABSORB**  
85/499,337 for the mark **CHLORABOND**  
85/499,332 for the mark **CHLORADRAPE**

Filed on December 19, 2011

Published in the *Official Gazette* on May 29, 2012

CAREFUSION 2200, INC.,

*Opposer,*

v.

ENTROTECH LIFE SCIENCES, INC.,

*Applicant.*

Combined Opposition Proceeding No.: 91-206,212

**DECLARATION OF ERIN M. HICKEY, ESQ.**

I, Erin M. Hickey, hereby declare and state as follows:

1. I am a Principal with the law firm of Fish & Richardson P.C., which represents Applicant Entrotech Life Sciences, Inc. (“Applicant”) in this proceeding. I am duly licensed to practice law in the states of California and New York, and am authorized to practice before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office. I have personal knowledge of the facts stated in this declaration and can and would testify truthfully thereto if called upon to do so.

2. Annexed hereto as **Exhibit A** are true and correct copies of pages 4 and 26 from the discovery deposition of John Halsey taken on December 12, 2014.



I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my personal knowledge and understanding.

Dated: May 1, 2015

Respectfully submitted,

**FISH & RICHARDSON P.C.**

/s/ Erin M. Hickey  
Erin M. Hickey  
*Attorney for Applicant,*  
ENTROTECH LIFE SCIENCES, INC.

# **EXHIBIT A**

1 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
2  
3 [REDACTED] [REDACTED]  
4 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
5  
6 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
7 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
8 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
9 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
10  
11 [REDACTED]  
12 [REDACTED] [REDACTED] [REDACTED]  
13 Q. [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
14 [REDACTED]  
15 A. [REDACTED] [REDACTED]  
16 Q. And what is your current occupation?  
17 A. I am a consultant for Entrotech Life Sciences.  
18 Q. [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
19 A. [REDACTED]  
20 Q. [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
21 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
22 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
23 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
24 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
25 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]

1 Q. [REDACTED]

2 [REDACTED]

3 [REDACTED]

4 A. [REDACTED]

5 [REDACTED]

6 [REDACTED]

7 Q. Okay. Now, you are no longer employed as an  
8 Entrotech Life Sciences employee; correct?

9 A. I am employed, I'm on payroll, but I'm acting  
10 as a consultant to Mr. McGuire, and I'm not involved  
11 in the day-to-day decision-making for Life Sciences.

12 Q. Okay. When did that happen?

13 A. October 24.

14 Q. Of --

15 A. 2014.

16 Q. [REDACTED]

17 A. [REDACTED]

18 Q. [REDACTED]

19 A. [REDACTED]

20 [REDACTED]

21 Q. [REDACTED]

22 [REDACTED]

23 A. [REDACTED]

24 [REDACTED]

25 Q. [REDACTED]